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Rec'd PCT/PTO

14 MAR 2002

10/088333

14 MAR 2002

Practitioner's Docket No. 100604.0009US1

CHAPTER II

Preliminary Classification:

Proposed Class:

Subclass:

TRANSMITTAL LETTER
TO THE UNITED STATES ELECTED OFFICE (EO/US)
(ENTRY INTO U.S. NATIONAL PHASE UNDER CHAPTER II)

| | | |
|----------------------------------|----------------------------|--------------------------------------|
| PCT/US99/23822 | 12 October 1999 (12.10.99) | None |
| International Application Number | International Filing Date | International Earliest Priority Date |

TITLE OF INVENTION: MULTI-PAGE EXECUTABLE COMMERCIALS

APPLICANT(S): Richard MCEWAN and Michael BRIOLA

Box PCT
U.S. Patent Office
P.O. Box 2327
Arlington, VA 22202
ATTENTION: EO/US

CERTIFICATION UNDER 37 C.F.R. SECTION 1.10*

(Express Mail label number is mandatory.)

(Express Mail certification is optional.)

I hereby certify that this paper, along with any document referred to, is being deposited with the United States Postal Service on this date March 14, 2002, in an envelope as "Express Mail Post Office to Addressee," mailing Label Number EL 722859807US, addressed to the: PO Box 2327, Arlington, VA 22202.

Kristin J. Azcona

WARNING: Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. Section 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

***WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. Section 1.10(b).
"Since the filing of correspondence under [Section] 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

1. Applicant herewith submits to the United States Elected Office (EO/US) the following items under 35 U.S.C. Section 371:

a. This express request to immediately begin national examination procedures (35 U.S.C. Section 371(f)).

b. The U.S. National Fee (35 U.S.C. Section 371(c)(1)) and other fees (37 C.F.R. Section 1.492) as indicated below:

2. Fees

| CLAIMS FEE* | (1) FOR | (2) NUMBER FILED | (3) NUMBER EXTRA | (4) RATE | (5) CALCULATIONS |
|--------------|--|------------------|------------------|-------------|------------------|
| | TOTAL CLAIMS | 14 - 20 = | 0 | x \$18.00 = | \$0.00 |
| | INDEPENDENT CLAIMS | 1 - 3 = | 0 | x \$80.00 = | \$0.00 |
| | MULTIPLE DEPENDENT CLAIM(S) (if applicable) + \$270.00 | | | | \$0.00 |
| BASIC FEE | U.S. PTO WAS INTERNATIONAL PRELIMINARY EXAMINATION AUTHORITY Where an International preliminary examination fee as set forth in Section 1.482 has been paid on the international application to the U.S. PTO: and the international preliminary examination report states that the criteria of novelty, inventive step (non-obviousness) and industrial activity, as defined in PCT Article 33(2) to (4) have been satisfied for all the claims presented in the application entering the national stage (37 C.F.R. Section 1.492(a)(4)) \$100.00 | | | | \$100.00 |
| | Total of above Calculations | | | | = \$100.00 |
| SMALL ENTITY | Reduction by 1/2 for filing by small entity, if applicable. Affidavit must be filed. (note 37 CFR Sections 1.9, 1.27, 1.28) | | | | - \$50.00 |
| | Subtotal | | | | \$50.00 |
| | Total National Fee | | | | \$50.00 |
| | Fee for recording the enclosed assignment document \$40.00 (37 C.F.R. Section 1.21(h)). See attached "ASSIGNMENT COVER SHEET". | | | | \$0.00 |
| TOTAL | Total Fees enclosed | | | | \$50.00 |

*See attached Preliminary Amendment Reducing the Number of Claims.

A check in the amount of \$50.00 to cover the above fees is enclosed.

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3. A copy of the International application as filed (35 U.S.C. Section 371(c)(2)) is not required, as the application was filed with the United States Receiving Office.
4. A translation of the International application into the English language (35 U.S.C. Section 371(c)(2)) is not required as the application was filed in English.
5. Amendments to the claims of the International application under PCT Article 19 (35 U.S.C. Section 371(c)(3)) are transmitted herewith.
6. A translation of the amendments to the claims under PCT Article 19 (38 U.S.C. Section 371(c)(3)) is not required as the amendments were made in the English language.
7. A copy of the international examination report (PCT/IPEA/409) is not required as the application was filed with the United States Receiving Office.
8. Annex(es) to the international preliminary examination report is/are not required as the application was filed with the United States Receiving Office.
9. A translation of the annexes to the international preliminary examination report is not required as the annexes are in the English language.
10. An oath or declaration of the inventor (35 U.S.C. Section 371(c)(4)) complying with 35 U.S.C. Section 115 is not submitted herewith, but will be submitted at a later date.

II. Other document(s) or information included:

11. An International Search Report (PCT/ISA/210) or Declaration under PCT Article 17(2)(a) is not required, as the application was searched by the United States International Searching Authority.
12. An Information Disclosure Statement under 37 C.F.R. Sections 1.97 and 1.98 will be transmitted within THREE MONTHS of the date of submission of requirements under 35 U.S.C. Section 371(c).
13. Additional documents:
 - a. Copy of request (PCT/RO/101)
 - b. Copy of front page of WIPO publication WO01/73640
14. The above items are being transmitted before 30 months from any claimed priority date.

AUTHORIZATION TO CHARGE ADDITIONAL FEES

The Commissioner is hereby authorized to charge the following additional fees that may be required by this paper and during the entire pendency of this application to Account No.: 500341

JCTU NOV 14 2002

37 C.F.R. Section 1.492(a)(1), (2), (3), and (4) (filing fees)

37 C.F.R. Section 1.492(b), (c), and (d) (presentation of extra claims)

37 C.F.R. Section 1.17 (application processing fees)

37 C.F.R. Section 1.17(a)(1)-(5) (extension fees pursuant to Section 1.136(a))

37 C.F.R. Section 1.492(e) and (f) (surcharge fees for filing the declaration and/or filing an English translation of an International Application later than 20 months after the priority date).

Date: March 14, 2002



Sandra P. Thompson
Rutan & Tucker, LLP
611 Anton Blvd., 14th Floor
Costa Mesa, CA 92626
USA

IN THE UNITED STATES INTERNATIONAL PRELIMINARY
EXAMINATION AUTHORITY (IPEA/US)

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10/088333

IC: Rec'd PCT/PTO 14 MAR 2002

| International Application Number | International Filing Date | International Earliest Priority Date |
|----------------------------------|---------------------------|--------------------------------------|
| PCT/US99/23822 | 12 October 1999 | None |

Title of Invention: **Multi-page Executable Commercials**
Applicant: **eCommercial.com, Inc.**

International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20
Switzerland

**LETTER FOR PCT ARTICLE 19 AMENDMENT OF CLAIMS
(PCT SECTION 205)**

1. Applicant herewith submits replacement sheets(s) number(ed) 14 - 15 to replace sheet(s) number(ed) 14 - 15, originally filed for this application.
2. In respect of each claim appearing in the international application based on the replacement sheets submitted herewith, and in accordance with PCT Section 205, the following claim(s) is/are:
 - (i) unchanged: claim(s): none
 - (ii) cancelled: claim(s): none
 - (iii) new: claim(s): none
 - (iv) replacement of one or more claims as filed, as follows: claim 1 is amended, and claims 2-13 were renumbered as claims 2-14.
 - (v) the result of the division of one or more claims as filed, as follows: none

Dear Sir:

This letter responds to the Search Report dated 8 February 2000.

Substitute Claim Sheets

Please substitute the attached substitute claim sheets numbered 14 & 15 for the previously filed claim sheets numbered 14 & 15. Claim 1 is amended as follows:

1. An electronic commercial received and opened by [communicated to] a recipient as part of an e-mail message independently of a web browser, [and residing locally

on the recipient's computer,] comprising a plurality of locally resident, recipient inter-navigable [navigable] pages that provide different content clips and user interface.

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The undersigned apologizes for the existence of two claims numbered claim 2. This defect is corrected herein, and the references are addressed individually with respect to the renumbered claims.

Cited References

The Office indicated that claims 1, 2 (both), 3-18, and 13 are anticipated by Shaw et al. (US 5809242), that claim 10 is anticipated by Farris et al. (US 5881131), and that claims 1, 4-8, that 13 are anticipated by Rosen (US 5995102). The Office also indicated that claims 1, 2 (both), 3-9, and 11-13 are obvious over Farris et al., and that claims 1-9 and 11-13 are obvious over Xue (US 5956709). The applicant disagrees with that assessment for the reasons set forth immediately below, especially as the claims have been amended herein.

Shaw et al.

Shaw teaches an advertising system in which commercials are downloaded to a client machine, and then displayed to the client while the client is using his e-mail. The commercials are not received as part of e-mail messages, and in fact are treated entirely different from e-mail messages. At col. 7, lines 48-51, for example, Shaw specifies that "[c]ontrol of the display of e-mail messages is independent to that of the control of the display of advertisements".

Claim 1 (and claims 2-14 by virtue of their dependence on claim 1) recites a commercial that is "communicated to a recipient as part of an e-mail message". The applicant intended that phrase to mean that the commercial was transmitted to the recipient as part of an e-mail message, not appended to someone else's e-mail message at the client side. In case this distinction was not entirely clear in the originally filed claims, the applicant amends the claims herein to recite the limitation that the commercial is "received . . . by" the recipient as part of an e-mail message. This modification entirely eliminates Shaw as a potentially anticipating reference.

It was also contemplated by the applicant that display of the commercial would be opened by the recipient as would any other e-mail message. (see e.g., eCommercial spec., page 4, line 25-28; page 7, lines 28-31; page 9, lines 10-11). When the e-mail is open, the recipient is presented with the commercial. When the e-mail is closed, the commercial disappears. It may be that this feature was also not sufficiently delineated in the originally filed claims, and that possible opacity is corrected herein by amending claim 1 (and claims 2-14 by dependency) to recite that the commercial is "opened by" the recipient as part of an e-mail message.

Still another aspect of the inventive subject matter is that the plurality of pages are navigable. By "navigable" is meant that the recipient (client, user, consumer, etc) controls the navigation, not some outside entity, or some software running on the recipient's

machine. This limitation is in sharp contrast to the teachings of Shaw, where the software controls the display. To clarify this limitation, claim 1 (and claims by dependency) are amended herein to recite that the various navigable commercial is "recipient" navigable.

Yet another aspect of the inventive subject matter is that commercial received by the recipient via e-mail, and stored locally to the recipient, itself contains multiple recipient navigable pages. In other words, the commercial originally received does not have to download other pages to be a multi-page commercial. This is exactly the opposite of Shaw, where multiple pages are downloaded at a later time by clicking on the "more information" button when the client program next connects to the server system. (spec., col. 6, lines 1-8). To clarify this limitation, claim 1 (and claims 2-14 by dependency) are amended herein to recite that the various navigable commercial is "recipient" navigable.

Yet another aspect of the inventive subject matter is that various navigable pages of the multi-page commercial are inter-navigable. That exact wording was not contained in originally filed specification, but was clearly contemplated. Every single one of the figures, for example, depicts the sample commercial as having multiple pages accessed by tabs. Moreover, specification page 3, lines 21-23, states that the tabs "may be used to navigate among the various pages." This use of "among" means that users can navigate from one to another of the tabbed displays. The next sentence also clarifies that "[t]he group of navigable pages may advantageously be referred to as a net-deck." This implies that the commercial is similar to a deck of cards, where anyone can access any of the cards in any order. To clarify this limitation, claim 1 (and claims 2-14 by dependency) are therefore amended herein to recite that the various navigable commercial is "recipient" navigable.

These and other claim changes are set forth below.

1. An electronic commercial received and opened by [communicated to] a recipient as part of an e-mail message independently of a web browser, [and residing locally on the recipient's computer,] comprising a plurality of locally resident, recipient inter-navigable [navigable] pages that provide different content clips and a user interface.

Shaw fails to anticipate many of the dependent claims for other reasons as well. Claim 3 (using the new claim numbers) recites that the commercial is an executable file. To the contrary, Shaw teaches the use of a "client program" that displays the various advertisements while the recipient is using his e-mail system. Since there is already a client program displaying the advertisements, it would be ridiculous in a system such as Shaw's for each advertisement to also contain the software needed to display itself. It makes much more sense to have a single program that display different advertisements at different times.

Claims 4 and 5 recite that at least two of the inter-navigable pages contain hyperlinks and branding graphics. There is no teaching, suggestion, or motivation in Shaw for two or more of the pages to be inter-navigable, let alone for multiple pages of such multiple page advertisements to have hyperlinks and branding graphics. From an efficiency standpoint, and according to a fair reading of Shaw, it appears that of the advertisements stored locally to the recipient, Shaw contemplates only single page advertisements with only single hyperlinks and branding graphics.

Claim 6 takes this a step further, reciting that at least one of the pages includes a third party incentive. Here, the third party refers to an entity other than the advertiser and the recipient. Shaw is entirely silent on the issue of third parties that may add incentives to commercials.

With respect to claim 7, Shaw has no teaching, suggestion, or motivation at all to use tabs in navigating among a plurality of pages from the same advertisement.

With respect to claim 14, Shaw teaches nothing whatever about a net-deck, i.e., a single commercial including numerous inter-navigable pages where each page can be accessed directly from each other page. Thus, the limitation of providing "an interface for ordering a customized net-deck based upon the recipient's selecting a plurality of items from a list" is entirely novel over Shaw.

Farris et al.

It is unclear to the undersigned why Farris et al. was cited against the pending application. Farris teaches a service order processing system for telephone companies. The gist of the invention is that instead of disconnecting the telephone lines and other resources when a customer leaves a given location, the phone company keeps the facilities intact for the next customer to occupy the location. That teaching has nothing whatever to do with the presently claimed subject matter.

Considering just claim 1 (as amended herein), Farris et al. fail to teach almost every limitation recited. First of all, Farris et al. teach nothing at all about electronic commercials, let alone electronic commercials being received or opened as part of e-mail messages. Farris deals with telephone lines and telephone resources, so there is no any teaching of any sort that electronic commercials can be resident locally to the recipient. Nor is there any teaching about commercials having multiple inter-navigable pages. Nor is there any teaching about the different pages having different content clips and user interfaces.

The same is true for all of the dependent claims. Harris has no teaching having to do with e-mail attachments (claim 2), executable files (claim 3), hyperlinks (claim 4), branding graphics (claim 5), third party incentives (claim 6), tabs (claim 7), background downloads (claim 8), opt-in mailing lists (claim 9), voting (claims 11 and 12), different topics (claim 13), and net deck (claim 14).

The sections specifically referenced with respect to Farris et al. in the Search Report were though not to be particularly relevant, either for anticipation or obviousness. Col. 22, lines 17-49 refer in general to e-mail as being one of several possible methods of communicating over the Internet, and there is some discussion of bulletin boards on which individuals could presumably post advertisements. There is, however, no discussion of sending multi-paged commercials over the Internet as part of an e-mail. Col. 24, lines 40-54 describe the basic operation of the web as involving web documents that contain hyperlinks. But there is no teaching, suggestion, or motivation in the text to use hyperlinks on multi-paged commercials that are received and opened as part of e-mail messages. Col. 26, lines 52-63 describe the use of e-mail, bulletin boards and so forth for non-commercial

purposes. If anything, that section teaches against the claimed subject matter because it teaches using the Internet for non-commercial purposes. Col. 28, lines 16-27 refers to HTML documents with fill-in-the-blank forms to request information about a visitor to a web site. Once again that teaching has nothing whatever to do with sending multi-paged commercials over the Internet as part of an e-mail.

Xue

Xue teaches the dynamic assembling of client side "shopping carts" as opposed to the more common server side "shopping carts". Xue fails to satisfy many of the limitations of the presently pending claims.

One of the most glaring omissions (especially as amended herein) is that the pending claims require the commercial to be "received and opened by a recipient as part of an e-mail message independently of a web browser". Support for the "independently" limitation can be found at eCommercial specification, page 2, lines 11-14; and abstract lines 4-5. Xue teaches against that limitation because Xue requires a web browser for operation. As stated unequivocally in the Xue abstract and at col. 2, lines 29-33, "A web browser . . . is needed to implement the method".

Xue fails to anticipate many of the dependent claims for other reasons as well. Claim 3 (using the new claim numbers) recites that the commercial is an executable file. Xue does indeed teach client side code, but that code is executed by the browser (hence the need for a browser), and is not by itself executable. Even if it were executable, the file is not received and opened as part of an e-mail, and is not itself a commercial. Thus, the executable file limitation of claim 3 is not satisfied.

Claims 4 and 5 recite that at least two the inter-navigable pages of the commercial contain hyperlinks and branding graphics. True, Xue appears to teach operation of code through the web browser that provides multiple navigable pages that display various aspects of the "shopping cart". But that is a long way from a commercial downloaded in an e-mail having inter-navigable pages as claimed.

Claim 6 takes this a step further, reciting that at least one of the pages includes a third party incentive. Here, the third party refers to an entity other than the advertiser and the recipient. Xue is entirely silent on the issue of third parties that may add incentives to commercials.

With respect to claim 7, Xue has no teaching, suggestion, or motivation at all to use tabs in navigating among a plurality of pages from the same advertisement.

With respect to claim 14, Xue teaches nothing whatever about a net-deck, i.e., a single commercial including numerous inter-navigable pages where each page can be accessed directly from each other page. Yes, Xue teaches something having multiple navigable pages, but that something is shopping cart code running inside a browser. That is not a commercial providing "an interface for ordering a customized net-deck based upon the recipient's selecting a plurality of items from a list" is entirely novel over Shaw.

Rosen

Rosen teaches modifying a user's cursor to act as an advertising tool. There is no teaching, suggestion or motivation in Rosen for an electronic commercial to be "received and opened by a recipient as part of an e-mail message".

In addition, although Rosen teaches downloading of multiple logos, advertisements and the like, those items are really multiple advertisements, not a single advertisement having multiple pages.

Even if the multiple advertisements were considered to be pages within a single commercial, the navigation among the "pages" would be controlled by an outside server (see spec, col. 3, lines 51-64). There is nothing in Rosen that teaches, suggests, or motivates one to provide a multi-page commercial in which the pages are inter-navigable pages by the recipient.

Failure to satisfy the various dependent claims should be apparent. The same is true for all of the dependent claims deemed to be anticipated. At col. 3, lines 28-35 Rosen describes how his modified cursors could be used to perform various functions, but there is no indication that any of those functions would have anything to do with either the user or the advertiser. Thus, there is no teaching, suggestion or motivation to use the advertising for third party incentives (claim 6). Rosen has no teaching at all having to do with downloading commercials that have tabs (claim 7), and such would in any event be contrary to Rosen's idea of keeping the advertising from dominating the display screen (see spec., col. 2, lines 4-33). Rosen also fails to teach anything about opt-in mailing lists (claim 9) or a net deck (claim 14).

Conclusion

None of the references anticipate or render the presently filed claims obvious. Among other things, none of the references teach, suggest or motivate downloading of multi-pages advertisements at e-mail part of e-mail messages. Where commercials are downloaded they are not playable in the absence of a web browser. Where navigation is contemplated, it is not recipient (i.e., user) navigable among the various pages.

Request for Conference

The present application is of the greatest personal importance to the applicant. If after considering the above arguments and the claim modifications the Authorized Officer still considers the claims to be unpatentable over the prior art, the undersigned would appreciate the opportunity to discuss this matter directly. This could be accomplished by

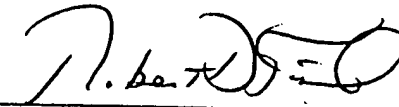
COPY

telephone, or if the Authorized Officer finds it appropriate, the undersigned would be pleased to come to Washington to discuss the same, and perhaps develop claims that would be considered allowable.

COPY

Respectfully submitted,
Fish & Associates, LLP

Dated: 6/3/00

By 
Robert D. Fish
Reg. No. 33,880

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IN THE UNITED STATES INTERNATIONAL PRELIMINARY
EXAMINATION AUTHORITY (IPEA/US)

| International Application Number | International Filing Date | International Earliest Priority Date |
|----------------------------------|---------------------------|--------------------------------------|
| PCT/US99/23822 | 12 October 1999 | None |

Title of Invention: **Multi-page Executable Commercials**
Applicant: **eCommercial.com, Inc.**

International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20
Switzerland

**LETTER FOR PCT ARTICLE 19 AMENDMENT OF CLAIMS
(PCT SECTION 205)**

1. Applicant herewith submits replacement sheets(s) number(ed) 14-15 to replace sheet(s) number(ed) 14-15, filed on or about 6 March 2000 for this application.
2. In respect of each claim appearing in the international application based on the replacement sheets submitted herewith, and in accordance with PCT Section 205, the following claim(s) is/are:
 - (i) unchanged: claim(s): 2-14
 - (ii) cancelled: claim(s): none
 - (iii) new: claim(s): none
 - (iv) replacement of one or more claims as filed, as follows: 1
 - (v) the result of the division of one or more claims as filed, as follows: none

Dear Sir:

This letter is a supplemental response to the Search Report dated 8 February 2000.

Substitute Claim Sheets

Please substitute the attached substitute claim sheets numbered 14 & 15 for the previously filed claim sheets numbered 14 & 15. Claim 1 is amended as follows:

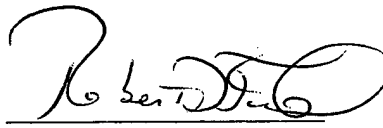
COPY

1. An electronic commercial received and opened by a recipient as part of an e-mail message independently of a web browser, comprising a plurality of locally resident, recipient inter-navigable pages that provide different embedded audio/video content clips and a user interface through which a user interacts other than to effect navigation among the pages.

Conference

The undersigned greatly appreciates the examiner and her supervisor taking the time to discuss the claims during an informal meeting on April 4, 2000.

Respectfully submitted,
Fish & Associates, LLP

By: 
Robert D. Fish
Reg. No. 33,880

Dated: April 11, 2000

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